

CASE NO.: HSJ920030231US1
Serial No.: 10/706,393
September 22, 2005
Page 6

PATENT
Filed: November 12, 2003

Rejections Under 35 U.S.C. §102

Claims 1 and 3 have been rejected under 35 U.S.C. §102 as being anticipated by Hussein, and Claim 18 has been rejected as being anticipated by Bryant et al.

Hussein, figure 1 and col. 4, lines 34 and 35 and col. 5, lines 42-60 have been relied on as a teaching of controlling a write gate to selectively enable writing data bits associated with a servo pattern. This appears to be incorrect. Nowhere does Hussein mention writing a servo pattern, something that ordinarily is done prior to vending the HDD. Indeed, Hussein appears to be directed to conventional disk operation. Thus, the disablement of the write gate by the servo controller discussed in col. 5 has nothing to do with writing data bits associated with a servo pattern as recited in Claim 1. The data written by Hussein is conventional client data, and the servo controller evidently is a conventional servo controller that coordinates slider positioning with data reading and writing, without having anything to do with writing a servo pattern.

Applicant notes that claims must be interpreted as one skilled in the art would interpret them, in light of the specification, MPEP §2111.01. As the examiner presumably is aware, the term "servo pattern" has a well-understood meaning in the art, and is something separate and distinct from the data that a client writes to a HDD. Nothing in the present specification leads away from this well-understood meaning. Accordingly, rejections based on allegations that Hussein has anything to do with writing servo patterns, much less by selectively enabling and disabling the write gate of the write channel of a HDD, much less still executing the selective enablement of the write gate responsive to write control bits in the servo pattern data being written, are overcome.

619-21.AMD

CASE NO.: HSJ920030231US1
Serial No.: 10/706,393
September 22, 2005
Page 7

PATENT
Filed: November 12, 2003

The anticipation rejection of Claim 18 has been overcome by adding the limitations of now-canceled Claim 19 to it. Amended Claim 18 will be discussed in the following section.

Rejections Under 35 U.S.C. §103

Claims 4 and 5 have been rejected under 35 U.S.C. §103 as being unpatentable over Hussein in view of Official Notice. Also, Claims 6 and 13-17 have been rejected as being unpatentable over Hussein in view of Bryant et al., and Claims 2, 7-12, and 19 have been rejected as being unpatentable over Bryant et al. in view of Hussein.

Turning first to the rejection of Claims 4 and 5, MPEP §2144.03 advises that the taking of official notice can be taken only of facts that "are capable of instant and unquestionable demonstration as to defy dispute", giving, as examples, adjusting flame intensity as needed for heat and tape recorders automatically erasing old data when new data is recorded onto them. Official notice of dependent claim limitations "might be appropriate" but only if the facts so noticed "are of notorious character".

Accordingly, official notice "is permissible only in some circumstances"; according to the MPEP official notice is most inappropriate of technical facts in areas of esoteric technology or of specific knowledge of the prior art. Still further, "ordinarily there must be some form of evidence in the record to support an assertion of common knowledge", and "general conclusions concerning what is basic knowledge without specific factual findings will not support an obviousness rejection."

It must be noted in addition that the question is not just whether various elements are well known, but also where the prior art supplies the motivation to combine the allegedly well-known features with the rest of the claimed elements. That is, regardless of how an element is identified in the prior art, i.e., using

1199-21.AMD

CASE NO.: HSJ920030231US1
Serial No.: 10/706,393
September 22, 2005
Page 8

PATENT
Filed: November 12, 2003

a reference or "official notice", the remaining task for an examiner is to show why the prior art suggests the element in the combination claimed.

Applying this guidance to Claims 4 and 5, the present rejections do not appear to comply with the MPEP. First, both claims recite using a specific number of bits in a bus of a particular size to encode write gate enablement. This is an example of a heretofore unknown and plainly esoteric technical area. The taking of official notice for that reason alone is inappropriate.

Second, what the examiner is taking official notice of is not what is claimed. Specifically, the examiner asserts that he is taking official notice of encoding any number of bits in a range of bits to enable or activate "the remaining number of bits", but Claims 4 and 5 do not enable a remaining number of bits, but rather a write gate. In essence, the examiner is taking official notice of a generality to reject a specifically recited element that is not otherwise shown in the relied-upon references. That is legally and logically improper.

For each and every taking of official notice, should the rejections be persisted in Applicant hereby requests not only a prior art showing under MPEP §2144.03 but also the requisite prior art suggestion to combine the allegedly well-known feature in the combination being rejected. Applicant explicitly traverses the taking of official notice for failing to comply with the above requirements of the MPEP.

Now considering independent Claim 7, note that Claim 7 recites self-writing a servo pattern to a disk using a write channel intended for subsequently writing user data, and further that based on write control bits associated with a received servo pattern, enabling and disabling a write gate associated with the write channel without deenergizing the write channel.

1189-21.AMD

CASE NO.: HSJ920030231US1
Serial No.: 10/706,393
September 22, 2005
Page 9

PATENT
Filed: November 12, 2003

That is not, however, how Bryant et al. works. Instead, when servo self-writing, Bryant et al. uses a channel and presumably a gate that are different from the ones used for writing user data, col. 8, lines 10-18 (the mux 178 switches off the data write circuit portion 186 in favor of the pattern generator circuit 176, while using the data read portion). In fact, the rejection admits as much, resorting to the above-discussed portions of Hussein to remedy the shortfall. But as discussed above, Hussein is not directed to servo pattern writing at all, so the allegation that it controls a write gate to write a servo pattern is incorrect. In other words, combining the references as proposed would not arrive at Claim 7.

Applicant further notes that in seeking to combine references, the name of the game is not the claim, but rather the requisite prior art suggestion to combine, MPEP §2143. The only rationale given for combining Hussein and Bryant et al. is because "they are from the same field of endeavor". Merely being from the same field does not rise to the requisite prior art suggestion to combine, of course. Otherwise, the entire obviousness inquiry would reduce to a mere showing of analoguousness under MPEP §2141, when in fact analoguousness is nothing more than a threshold starting point for determining whether the subsequent analysis required under MPEP §2143 properly may be undertaken. The ensuing recognition by the examiner of why it would be useful to control the write gate using write control bits comes not from the relied-upon references, which nowhere consider it, but from a reading of the present specification. Since the present specification does not form part of the prior art, the references have been improperly combined.

The rejection of Claim 8 (reciting that a write control bit is associated with at least one data bit) is likewise legally deficient, being based on an admission that while the relied-upon references fail to teach it, it nonetheless would have been obvious based on a "change of size" theory. The reliance on Rose is inapposite. Applicant is not claiming a differently-sized element that is otherwise shown in the prior art.

1189-21.AMD

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(TUE) SEP 27 2005 8:40/ST. 8:37/No. 6833031245 P 12

CASE NO.: HSJ920030231US1
Serial No.: 10/706,393
September 22, 2005
Page 10

PATENT
Filed: November 12, 2003

Applicant is claiming a specific relationship between a write control bit and a data bit. Relationships between data elements are not sizes. For the same reason, the rejections of Claims 8 and 9 on the same basis are overcome.

Next considering Claim 18, which incorporates the limitations of now-canceled Claim 19, the same deficiencies that attend the rejection of Claim 7, supra are present in the rejection of Claim 19. Accordingly, for reasons advanced above amended Claim 18 is patentable.

The Examiner is cordially invited to telephone the undersigned at (619) 338-8075 for any reason which would advance the instant application to allowance.

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1189-21.AMD